

S/N 10/022,559

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	PETROGIANNIS et al.	Examiner:	William S. Powers
Serial No.:	10/022,559	Group Art Unit:	2434
Filed:	December 14, 2001	Docket No.:	09680.0188USU1
Customer No.	23552	Confirmation No.	3770
Title:	WEB-BASED METHOD AND SYSTEM FOR APPLYING A LEGALLY ENFORCEABLE SIGNATURE ON AN ELECTRONIC DOCUMENT		

REPLY BRIEF
IN RESPONSE TO EXAMINER'S
RESPONSE TO APPEAL BRIEF

Mail Stop APPEAL
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Examiner's Response to Appeal Brief, Applicants submit the following
Reply Brief.

Remarks:

Applicants have read and considered the Examiner's comments in response to the Appeal Brief filed on April 19, 2010. A petition for a 2 month extension of time under § 1.136(b) was filed on September 1, 2010, extending the period for response to November 1, 2010. Applicants still assert that the Patent Office has not demonstrated a *prima facie* case of obviousness, as explained in detail in the Appeal Brief as filed.

The response to the Appeal Brief states repeatedly that the Applicants are engaging in "piecemeal prosecution", referring to the fact that the Applicants have presented arguments against the cited references individually, and that one cannot show non-obviousness by attacking references individually where rejections are based on combinations of references, citing *In re Keller*.

Regarding this issue, Applicants assert that the first two steps of the factual inquiry set forth in *Graham v. John Deere* call for:

- 1) determining the scope and content of the prior art;
- 2) ascertaining the differences between the prior art and the claims at issue.

In the Appeal Brief, the Applicants reviewed each element of claim 1 and the Examiner's assertion regarding the prior art to demonstrate that several mistakes in determining the scope and content of the prior art were made in the last Office Action, as well as mistakes with respect to the (lack of) differences between the prior art and claim 1. Such a demonstration can only be made by analyzing the teachings of each cited piece of prior art with respect to a given claim element. This type of analysis therefore constitutes a proper application of the legal principles involved, and should therefore be fully considered by the Patent Appeal Board. Applicants assert that only one reference was cited for certain features of the recited combination as the

other references fail to teach or suggest these limitations and could not be relied upon and were not cited. As none of the prior art or the combination teaches or suggests each and every limitation, a prima facie case of obviousness has not been established.

In addition, the Applicants believe that the requirements of *In re Keller* have been misrepresented. Applicants assert that *In re Keller* is applicable only when a combination of references teaches all the limitations of the claimed invention. In that situation, *In re Keller* stands for the proposition that in such a scenario, an obviousness rejection cannot be overcome by attacking the references individually. However, in the present case, the references have been addressed in order to demonstrate that even the combination does not teach all the limitations of the claimed invention, contrary to what is suggested in the Final Office Action and the Examiner's Response. Moreover, none of the cited references or the combination of the cited references teach or suggest every limitation. The teachings of *In re Keller* are therefore not applicable to the present case.

In particular, Applicants assert that the Patent Office has not established that **any of the cited prior art** documents teach the following elements of claim 1:

- modules on a server presenting a user with a web-based representation of a document in a web browser;
- presenting the user with legal information related to the signing of a document and getting agreement from the user of the legal information in the web browser;
- applying a signature of a user on the document on the server upon agreement of the legal information from the user;
- generating, on a server, a process log comprising a record of substeps b) i) to b) iii) of claim 1 as executed and allowing the reconstruction of the web-based representation of a document and of the legal information as presented to the user through said web browser.

Finally, several times throughout the prosecution of this application it has been stated that Applicants have repeatedly limited their arguments to the specific passages cited by the Examiner. It is Applicants' duty to let the Patent Office know if they are in disagreement with the Examiner's assertions on the teachings of a particular passage of a cited reference, in keeping with the inquiries of *Graham v. John Deere*. Moreover, although the specific passages cited in the Final Office Actions and the Examiner's Response have been used as a starting point to demonstrate the errors in reasoning on which the rejections of the present claims are based, other possibly relevant passages have also been addressed, such as the paragraph dealing with the one web embodiment of Smithies. Moreover, the burden is on the Patent Office to demonstrate that claim limitations are taught by the prior art, and not on the Applicants to show that they are not. Applicants assert that the Patent Office has not met this burden for all limitations and that a *prima facie* case of obviousness has not been established.

A speedy and favorable action in the form of a Notice of Allowance is hereby solicited. If the Examiner feels that a telephone interview may be helpful in this matter, please contact Applicant's representative at (612) 336-4728.

Please consider this a PETITION FOR EXTENSION OF TIME for a sufficient number of months to enter these papers or any future reply, if appropriate. Please charge any additional fees or credit overpayment to Deposit Account No. 13-2725.

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Respectfully submitted,

MERCHANT & GOULD P.C.

Dated: _____

11/1/10

By: _____

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